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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JACKY JOACHIM,
PHILLIPPE ESPIARD,
BRUNO MAHIEUXE,
ROGER GILBERT,
WOLFGANG HOLSTEIN,
and GERALD AMANNT

Appeal 2008-1904
Application 09/786,113
Technology Center

Oral Hearing Held: May 14, 2008

Before CHUNG K. PAK, LINDA M. GAUDETTE,
and MICHAEL P. COLAIANNI, Administrative Patent Judges

ON BEHALF OF THE APPELLANT:

HARRIS A. PITLICK, ESQUIRE
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1 The above-entitled matter came on for hearing on Wednesday, May
2 14, 2008, commencing at 10:37 a.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia, before Paula
4 Lowery, Notary Registration No. 162073, Notary Public.

5 THE CLERK: Good morning. Calendar Number 20, Appeal
6 Number 2008-1904, Mr. Pitlick.

7 JUDGE PAK: Mr. Pitlick.

8 MR. PITLICK: Good morning.

9 JUDGE PAK: You've got 20 minutes. Our court reporter,
10 Paula Lowery, will transcribe the hearing and the transcript will become part
11 of the record. You may start any time you wish.

12 MR. PITLICK: Present inventions -- and there are a number of
13 independent claims here -- has to do with a process of making an insulation
14 product and the product itself.

15 It's based on Applicant's discovery that when you're adding a
16 thermal setting polymer size, either with it or subsequently, including a
17 particular latex, results in a product that has superior properties, especially
18 after aging.

19 These properties and the data showing improvement are all in
20 the specification, I might add, because I'm not going to cover everything
21 that's been said in the appeal brief and reply brief, but we continue to
22 maintain.

23 The examiner primarily relies on this Kennedy reference. As
24 we pointed out in our briefs, the difference between Kennedy -- there are
25 two.

26 One of the main differences, that Kennedy talks about a binder,

1 and we're talking about a size. We've asked the Board to take official notice
2 of the fact that they are different.

3 We pointed out in our appeal brief Kennedy, et al., is actually
4 the appropriate name we're using for the reference actually discloses that a
5 size can be added. So even Kennedy appreciates the fact there's a difference
6 between a size and a binder.

7 Our latex -- basically, we have two possibilities. The one the
8 examiner is relying on is the one that requires that every monomer -- well,
9 rather than paraphrase, let me read it.

10 "Every monomer in this particular embodiment has at least one
11 hydrosolic functional group selected from the group consisting of hydroxyl,
12 carboxyl and ester."

13 As we pointed out in Kennedy, their binder -- I should say their
14 fiber resistant latex -- basically is required to be halogenated, and there's no
15 disclosure in Kennedy, et al., that every monomer have the particular
16 hydrosolic functional group I just mentioned.

17 So at least on these two grounds we distinguish over Kennedy,
18 et al., Kennedy, et al., has been used in all the rejections.

19 The examiner relies on various other references, such as
20 Kajander (phonetic), which basically show how these mineral products are
21 made. We don't challenge the fact they are made by, for example, melting
22 glass or rock, mineral composition, and fiberizing them, and then applying a
23 size.

24 One skilled in the art would not combine these references, or
25 perhaps would combine these references with Kennedy to make perhaps the
26 starting material of Kennedy.

1 Certainly since we're adding a latex before we cure the size,
2 rather than in the formation of a binder, it certainly would be a difference in
3 kind as opposed to degree between our invention and Kennedy or Kennedy,
4 et al., modified by any of the prior art.

5 We argued that there is no prima facie case of obviousness. Yet
6 there is quite a fair amount of comparative data in the specification, which
7 shows again the significance, especially upon aging of various mechanical
8 properties of our invention, compared to a similar invention without the use
9 of the hydrophilic latex.

10 JUDGE PAK: Two questions. The first question is, what's the
11 function of the sizing composition you are claiming? The second question
12 is, did you refer to all those examples in your brief?

13 MR. PITLICK: I'm sorry, would you repeat the second
14 question?

15 JUDGE PAK: The data you are referring to, did you rely on
16 them in your opening brief?

17 MR. PITLICK: In answer to your first question, our size is
18 being used, as sizers are traditionally used, to size the fibers before they're
19 gathered and formed into a web or mat.

20 I can't give you specifically a definition of size because I don't
21 want to be testifying, but we're using size in its conventional usage.

22 With respect to the comparative data in the specifications as to
23 whether we talked about it in the appeal brief, I'm pretty sure we did. I just
24 want to verify that.

25 In the introduction of the art -- the preface beginning on page 7
26 -- specifically the first full paragraph. I'm sorry, the paragraph 13, pages 7

1 and 8, we do talk about that comparative data. So yes, we do talk about it in
2 the appeal brief.

3 As I said, the examiner basically has devoted perhaps one line
4 in the examiner's answer saying it's not commensurate to go with the claims.

5 I might add, Judge Pak, it dawned on me when I was reviewing
6 for this appeal, there was a previous appeal here, and the Board remanded
7 the case back to the examiner.

8 I didn't consider it to be a related appeal, but I guess if you take
9 an expansive view of the meaning and scope of what the rules contemplate
10 for related appeals, I probably should mention that.

11 I'm not sure if the Board would ordinarily know that. But there
12 was an earlier appeal that, again, was remanded to the examiner because the
13 Board felt there were certain things the examiner had not done.

14 For the Board's information, that appeal number was 2006-
15 1868. Again, I apologize if I was required to list that appeal in my related
16 appeals.

17 As I say, we submit there is no prima facie case of obviousness
18 as argued, but if there was, certainly the results -- the wealth of results -- it's
19 not just one or two examples; I think there are close to ten or so, all
20 comparing basically the same subject matter with or without the hydrophilic
21 latex.

22 Again, our mention is always superior to the same subject
23 matter without the latex.

24 So unless there are further questions, that's really all I have to
25 add.

26 JUDGE PAK: Any questions?

- 1 JUDGE COLAIANNI: No questions.
- 2 JUDGE PAK: Thank you for coming.
- 3 Whereupon, the proceedings at 10:45 a.m. were concluded.
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